

Appl. No. 10/604,144
Amdt. dated June 17, 2005

REMARKS

In the Office Action of February 17, 2005, claims 18-25 were rejected under 35 U.S.C. § 103 as being unpatentable over Matsumoto U.S. Patent No. DES 390,435 ("*Matsumoto*").

In response to the Office Action, Applicant herein amends the claims and requests reconsideration thereof in view of the following remarks. In accordance with 37 CFR § 1.121(f), Applicant submits that the amendments made herein introduce no new matter into the application.

I. The Circular Saw Blade of the Present Invention

The circular saw blade of the present invention comprises a saw blade having a planar saw body and a cutting edge that encircles the planar saw body as shown, for example, in FIG. 4 of the present application. Further as shown in FIG. 4, the saw body includes a planar annular section. The annular section has oppositely facing parallel surfaces which pass directly between lubricating guide supports when the saw blade is used in a saw arrangement as shown, for example, in FIG. 1. The annular section further has a substantially uniform axial thickness no greater than 0.080 inches between the oppositely facing parallel surfaces. The annular section thereby generally lies in a plane, which is what is meant by reference to the annular section being "planar".

In further accordance with this invention of claim 18, the planar annular section of the saw body defines a plurality of cavities therein, and each one of the cavities is sufficient to receive liquid therein for transport from the lubricating guide supports when used with the lubricating guide supports of the saw arrangement of FIG. 1.

II. The Saw Blade of *Matsumoto*

The disclosure of *Matsumoto* relates to the patentable design (ornamental) of a diamond abrasive saw blade. The *Matsumoto* blade includes a saw body and a cutting edge. The cutting edge defines a circular periphery of the saw blade, and six symmetrically spaced triangular openings are defined in the saw body. Furthermore, as clearly shown by

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Matsumoto in FIGS. 3-4 thereof, the saw blade is "hubcap" shaped and includes downward sloping surfaces extending from a hub to the cutting edge of the saw blade. The cavities in the saw blade are defined in these downward sloping surfaces.

In contrast to the circular saw blade of the present invention, *Matsumoto* fails to disclose or suggest a saw body having a planar annular section in which the recited cavities are defined. Additionally, because *Matsumoto* fails to disclose or suggest a planar annular section, *Matsumoto* also fails to disclose or suggest the oppositely facing parallel surfaces that define the planar annular section and the substantially uniform axial thickness that extends between these parallel planar surfaces. Applicant submits that these features are necessary in order for the recited circular saw blade to be effectively utilized with the intended saw arrangements having lubricating saw guides as shown in FIG. 1 of the present application.

Applicant also notes that *Matsumoto* further fails to disclose or suggest that the cavities should be sufficient to receive liquid therein for transport. Indeed, *Matsumoto* fails to disclose or teach that the triangular openings serve any function whatsoever apart from the ornamental design of the saw blade that is being claimed in the design patent.

Similarly, *Matsumoto* fails to disclose or suggest that a planar section of the saw blade should have an axial extent between the oppositely facing parallel surfaces of no greater than 0.080 inches as recited. Nothing in the references of record suggest these features such that one of ordinary skill in the art would be motivated to modify the saw blade of *Matsumoto* as asserted in the Office Action. One having ordinary skill in the art would first have to modify the saw blade of *Matsumoto* to include a planar annular section defining the triangular cavities and then further modify the thickness of this planar annular section to have a thickness no greater than 0.080 inches. These modification are far from mere design choices.

Indeed, with specific regard to the thickness of the planar annular section, it is clear from the specification of the present application that one of ordinary skill in the art would recognize that circular saw blades for cutting Southern Yellow Pine would not be less than 0.080 inches and even at that reduced thickness, a lubricating saw guides would have to be

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used in accordance with McGehee U.S. Patent No. 4,848,200. Applicant currently is unaware of any reference of record that discloses a thinner circular saw blade as recited and, accordingly, Applicant submits that there is no support for the general proposition that an ordinary or routine design choice for a saw blade would include a saw blade having a planar annular section with thickness of no greater than 0.080 inches.

III. The (Amended) Claims

Claim 18 is amended to emphasize differences of the recited circular saw blade over the disclosure of *Matsumoto*. In particular, claim 18 as amended now recites that the circular saw blade includes "a planar saw body and a cutting edge encircling said planar saw body, said planar saw body having a planar annular section." Claim 18 further recites that this planar annular section has "oppositely facing parallel surfaces" and "a substantially uniform axial thickness no greater than 0.080 inches between said oppositely facing parallel surfaces." Finally, claim 18 clarifies that this planar annular section defines the "plurality of cavities", "each one of said cavities being sufficient to receive liquid therein for transport." Dependent claims are amended to conform to amendments of the independent claim.

Applicant submits that amended claim 18 patentably defines over the disclosure of *Matsumoto*, and Applicant respectfully requests withdrawal of the rejection of claim 18 under § 103 based on *Matsumoto*.

Applicant further submits that the dependent claims also patentably define over the disclosure of *Matsumoto* for the reasons that claim 18 patentably defines over this reference, and because of the additional limitations recited in the dependent claims. For instance, Applicant submits that the *Matsumoto* fails to disclose or suggest: that each one of the cavities should have a triangular cross-section, a trailing edge of which is oriented at negative 5 degrees to a radius of the saw body (claim 20); that each one of said cavities should include a radial dimension greater than 0.015 inches such that each one of said cavities is sufficient to receive liquid therein for transport (claim 21); or that each one of said cavities should extend completely through planar annular section of said saw body between

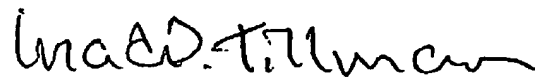
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said oppositely facing parallel surfaces (claim 22). These recited features simply are not obvious matters of design choice.

IV. Conclusion

Applicant submits that the § 103 rejection of the claims based on *Matsumoto* as set forth in the Office Action has been overcome, and Applicant respectfully requests withdrawal of this rejection.

Respectfully submitted,
Tillman Ivsan, PLLC



Chad D. Tillman
Reg. No. 38,634
Tel: (704) 248-6292
Fax: (877) 248-5100

PO Box 471581
Charlotte, NC 28247